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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/759,525 | 01/16/2004 | Edward M. Goldsmith | 949797-100029US | 7039 |
| 34026 | 7590 | 05/09/2006 | EXAMINER | |
| JONES DAY 555 SOUTH FLOWER STREET FIFTIETH FLOOR LOS ANGELES, CA 90071 | | | GRAHAM, MARK S | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3711 | |

DATE MAILED: 05/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/759,525 | GOLDSMITH ET AL. |
| | Examiner | Art Unit |
| | Mark S. Graham | 3711 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 March 2006.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 30-37,40,42-49 and 108-110 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 30-37,40,42-49 and 108-110 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-37, 40, 42-49, and 108-110 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christian '661 (Christian) in view of Tiitola. Christian discloses the claimed device with the exception of the use of a foam core blade as claimed. However, as disclosed by Tiitola it is known in the art to use a foam core blade as claimed. As Tiitola discloses, (Col. 1) such a blade is designed to be of better quality than known blades such as Christian's. It would have been obvious to one of ordinary skill in the art to have used a foam core blade such as disclosed by Tiitola for Christian's blade to improve its quality.

Concerning the amendments to claim 30, when a fiber composite blade such as Tiitola's is joined to the hosel in the manner disclosed by Christian the fibers of the blade necessarily have to be between the recessed heel section and the slot.

With regard to claim 43, Tiitola's fibers 44 where they occur in the bridges are non-continuous. Also Tiitola's claims are not limited to continuous strands and furthermore removing the continuous nature of the strands with the corresponding loss of strength would have been obvious to one of ordinary skill in the art.

Concerning both claims 43 and 45, for one using a blade such as Tiitola's with a fastening system such as Christian's the bridge structures and fibers necessarily have to terminate at the recessed front and back side as well as the front and back side of the striking portion of blade. One of ordinary skill in the art using Tiitola's blade in a fastening

system such as Christian's would obviously want to maintain the structural integrity of the blade throughout its length and would not remove the structural features within the portion of the blade being attached to the hosel.

Regarding claims 109 and 110, Christian only specifically discloses wood. However the examiner takes official notice that the use of wood laminates to form wooden portions of hockey sticks is commonly known in the art to impart to strength to the particular wooden part. It would have been obvious to one of ordinary skill in the art to have done the same with Christian's wooden hosel for the same reason.

In response to applicant's arguments and the submitted declaration, it is the examiner's opinion that Christian discloses the claimed device with the exception of the type of blade used. However, numerous blade constructs are known in the art including that of Tiitola which meets the limitations of the blade claimed by applicant. Moreover, Tiitola provides a specific teaching that blades such as his are intended to improve upon blades such as Christian's. (See again Col. 1 of Tiitola). Thus, the ordinarily skilled artisan has been presented with the blade fastening being claimed (Christian), the type of blade being claimed (Tiitola) and a specific teaching in the references themselves to improve the blade of the Christian type with one of the Tiitola construction. As such the ordinarily skilled artisan would have had a strong motivation to combine the references which results in arrival of the applicant's claimed invention. Under 35 U.S.C. 103 therefore the examiner cannot find the claimed blade to be patentable.

Concerning the commercial success argued by the applicant with regard to the Goldsmith declaration, no nexus between the commercial success alleged and the particularly claimed features of the hockey stick blade has been shown.

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Applicant's arguments filed 3/14/06 have been fully considered but they are not persuasive. Regarding the applicant's request for an interview the examiner may be contacted at the number below to schedule an interview time if necessary.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
5/1/06



Mark S. Graham
Primary Examiner